

REMARKS

Amendment to Abstract

In the Office Action, the Examiner objected to the Abstract of the Disclosure because the original Abstract exceeded 150 words. Accordingly, the original Abstract has been deleted and a new Abstract that does not exceed the 150-word limit is submitted herewith.

Claim Status

Claims 1-29 are pending in the application. Claims 19, 22, and 23 have been amended.

Novelty and Unobviousness

The Office Action rejected claims 1, 3, and 7-14 of the application under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 5,564,037 to Lam ("Lam" hereinafter) in view of U.S. Patent Number 6,317,844 to Kleiman ("Kleiman" hereinafter). We respectfully traverse this rejection.

The Kleiman patent has been assigned to Network Appliance, Inc. The present application was either assigned to or under an obligation of assignment to Network Appliance, Inc. at the time the present invention was made, as evidenced by the assignment document executed in this case on October 10, 2001, and recorded on reel/frame 012082/0432.

It appears that Kleiman qualifies as prior art only under 35 U.S.C. 102(e), because it issued on November 13, 2001, after the filing date of the present application. Kleiman therefore does not preclude patentability of claims of the present application, because 35 U.S.C. § 103 provides that

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 103(c). See also MANUAL OF PATENT EXAMINING PROCEDURE §2146 (8th ed., rev. 1, Feb. 2003). (We will refer to sections of the manual as “MPEP § ____“ hereinafter). Because the claimed invention and the subject matter of Kleiman were both owned by Network Appliance, Inc., at the time the present invention was made, Kleiman should not be used as prior art under section 103.

Claims 15, 18, and 21 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Number 6,269,431 to Dunham. According to the Office Action, Dunham teaches the limitations of claim 15 at col. 13, lines 1-11; and the limitations of claims 18 and 21 at col. 14, lines 43-49. We respectfully traverse this rejection and request reconsideration.

It appears that the rationale of these rejections is based on equating Dunham’s “secondary data storage” with “zombie filesystem not accessible to users” recited in claims 15, 18, and 21. According to the *Lexicography* section of the present application, the term *zombie filesystem* “generally refers to a portion of the file system where files are not available to users in normal operation, but can still be manipulated by the file system as if they were normal files.” Application,

storage" (or other filespace) as "zombie filespace" or as filespace not accessible to users. Indeed, Dunham appears to teach that a user can issue a command to copy a file to the secondary data storage:

In the data processing system of FIG. 1, the backup data in the secondary storage 29 is not updated every time that the host 20 writes new data to the primary data storage subsystem. Instead, specified data in the primary storage 27 is copied to the secondary storage 29 when the primary data storage subsystem 21 receives a backup command from the host 20. The host 20 may issue such a backup command at the request of the user 23 or at the request of an application program being executed by the host.

Dunham, at col. 5, lines 26-34. The user of Dunham's system can therefore issue a command that will result in a file being copied from the primary data storage subsystem to the secondary storage. Dunham's secondary storage is thus accessible to the user.

Independent claims 24 and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kleiman. In particular, the Office Action cites Kleiman at col. 3, lines 34-51 as teaching the methods of claims 24 and 27. The undersigned has read through the cited portion of Kleiman, as well as through the rest of Kleiman's specification, but has not found a reference to zombie filespace or to any filespace not accessible to users. We therefore respectfully traverse rejection of claims 24 and 27, and request the Examiner to reconsider the rejection.

The above discussion addresses all independent claims of the present application. As regards dependent claims of the application, they are patentable together with their respective base claims and intervening claims, if any.

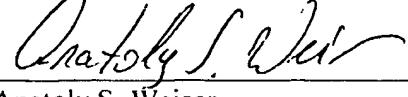
CONCLUSION

For the foregoing reasons, Applicants respectfully submit that all pending claims are patentable over references of record. To discuss any matter pertaining to the present application, the Examiner is invited to call the undersigned attorney at (858) 720-9431.

Having made an effort to bring the application in condition for allowance, a timely notice to this effect is earnestly solicited.

Respectfully submitted,

Dated: 4/28/2004


Anatoly S. Weiser
Reg. No. 43,229

The Swernofsky Law Group
P.O. Box 390013
Mountain View, CA 94039-0013
(650) 947-0700